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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,349	08/23/2005	Watling Jason	322-00089	8333
26753 7590 11/09/2007 ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202			EXAMINER ZIMMER, MARC S	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 11/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,349	Applicant(s) JASON ET AL.	
	Examiner Marc S. Zimmer	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,8,11,14,15,18,19,22,24,27 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5,8,11,15,18,19,22,24,27 and 32 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5, 8, 11, 15, 18, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Lutz et al., U.S. patent # 5,246,979. Columns 3-5, and particularly column 5, lines 12-30, teach acrylamide-functionalized polymers meeting all of the limitations of the aforementioned claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8, 11, 18-19, 22, 24, 27 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodd et al., U.S. Patent # 6,737,496.

Response to Arguments

It is Applicant's contention that Hodd fails to render obvious the claimed invention insofar as the modulus described therein, at "below 55" and "typically 20-50 kPa" is

significantly higher than that being claimed. The Examiner has reviewed the Hodd disclosure and it is noted that the modulus reported therein is *shear* modulus which, as the Examiner understands these measurements is a different parameter. See the Table.

The Examiner disagrees that a macromonomer bearing both terminal and pendant polymerizable groups Z are not taught by Hodd. Again, the paragraph bridging columns 5 and 6 does, in fact, contemplate polymer materials containing polymerizable groups at both locations.

Hodd further contemplates linear polymer materials that contain phenyl groups and/or perfluoroalkyl groups in addition to the polymerizable groups and alkyl (usually methyl) groups. It is notable that, in all preferred embodiments of their invention, the molar contribution of dialkylsiloxane content is greater than 50%.

It is also acknowledged that a favored permutation of the polymers taught by Hodd is that wherein the polymer contains fluoroalkyl and aromatic group substitution simultaneously. This does not, in the Examiner's estimation represent a teaching away from Applicant's stipulation that, "o + p = 0 when L or R₁ contain fluorine." Indeed, "disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments." *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989).

It is implied by Applicants that their invention should be deemed patentable over the prior art because "where a macromonomer is terminally-functionalized and pendantly-functionalized, it (modulus)... is expected to be higher than the range recited in claim 5." (This argument was offered in the traversal of the rejection over Qureshi but is applicable here too.) This argument is completely unsubstantiated and appears to be an overgeneralization. The modulus of elasticity is essentially a reflection of an elastomer's resistance to elongation/deformation, i.e. its rigidity. The skilled artisan will appreciate that the rigidity of an elastomer relates to the number of crosslinks and, more precisely, the number of crosslinks as a function of the chain length of the elastomer. Where the degree of polymerization is fairly high and the number of crosslinking sites low, the skilled artisan would expect the modulus to be low even were one or more of the crosslinkable groups to be present at pendant positions. As to the question of whether it would be obvious for the practitioner of Hodd's invention to construct a polymer that provides a modulus of elasticity in the range outlined by Applicant, the Examiner believes that it would be obvious because the goal would be to match as closely as possible the modulus of elasticity of the natural lens that is being replaced, which is low.

Finally, to address the matter of whether a given polymer is crosslinkable in vivo, Applicant says only that it is an objective to design a polymer that will not be extractable. Apparently, this is achieved merely by employing polymer materials containing both terminal- and pendant functional groups. Insofar as polymers adhering to this substitution pattern are contemplated by the reference, this limitation is satisfied.

Concerning *Lutz*, this document expressly discloses a polymer adhering to all of the property limitations associated with Applicant's claimed macromonomer. Therefore, it inherently satisfies the property limitations introduced into base claim 5. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established."

The fact that Lutz does not desire to employ the anticipatory copolymer in the same capacity is immaterial as Applicant's claims are directed to a macromonomer, not an intraocular lens.

As for the rejections over *Qureshi*, these are withdrawn only because a different curing mechanism is used therein and, therefore, it cannot be stated with complete confidence that that property limitations introduced into claim 5 would be inherently satisfied. All references to hardness by Applicant are those for the cured elastomer blended with a cured phenolic resin. That is to say, the silicone elastomer, itself, is not necessarily hard, i.e. inflexible.

Allowable Subject Matter

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

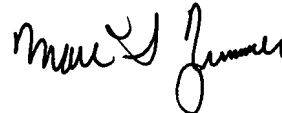
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

November 5, 2007

A handwritten signature in black ink, appearing to read "Marc S. Zimmer".

MARC S. ZIMMER
PRIMARY EXAMINER